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EIJIRO WATANABE

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EXAMINER

KRUSE, DAVID H

ART UNIT

PAPER NUMBER

1638

NOTIFICATION DATE

DELIVERY MODE

05/30/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte EIJIRO WATANABE and KENJI OEDA

Appeal 2007-4459
Application 08/992,914
Technology Center 1600

Decided: May 28, 2008

Before DONALD E. ADAMS, DEMETRA J. MILLS, and
LORA M. GREEN, *Administrative Patent Judges*.

MILLS, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

Claim 52 is representative.

52. An isolated nucleic acid comprising a nucleotide sequence coding for an amino acid sequence of a protein which produces raffinose by combining a D-galactosyl group through an α (1 \rightarrow 6) bond with a hydroxyl group attached to the carbon atom at position 6 of a D-glucose residue in a sucrose molecule, wherein said nucleotide sequence comprises a nucleotide sequence selected from the group consisting of

- (a) a nucleotide sequence of SEQ ID NO: 1,
- (b) a nucleotide sequence encoding the amino acid sequence of SEQ ID NO:2,

- (c) a nucleotide sequence of SEQ ID NO:3,
- (d) a nucleotide sequence encoding the amino acid sequence of SEQ ID NO:4,
- (e) a nucleotide sequence of SEQ ID NO:5,
- (f) a nucleotide sequence encoding the amino acid sequence of SEQ ID NO:6,
- (g) a nucleotide sequence of SEQ ID NO:7, and
- (h) a nucleotide sequence encoding the amino acid sequence of SEQ ID NO:8.

Grounds of Rejection

1. Claims 46-51 stand rejected under 35 U.S.C. § 101 as lacking utility.
2. Claim 52-74, 77 and 82-86 stand rejected under 35 U.S.C. § 112, first paragraph for lack of written description.
3. Claim 46-77 and 78-86 stand rejected under 35 U.S.C. § 112, first paragraph for lack of enablement.
4. Claims 46, 47, 52, 53, 55, 59-77 and 77-86 stand provisionally rejected for obviousness-type double patenting over copending application No. 09/301,766, claims 1-3, 16-23 and 28-30.

DISCUSSION

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the Examiner to consider the following issues and take appropriate action.

The Appellants argue in the Reply Brief that new evidence to support the Examiner's rejections is cited in the Answer. (Reply Br. 3.) In

particular, Appellants argue that Osumi¹ and its SEQ ID NO:24 is newly presented. (Reply Br. 3.) The Examiner further acknowledges that Osumi is newly cited. (Ans. 3.) Appellants assert that “all of the Examiner’s arguments that rely upon the newly introduced evidence of the Osumi patent and the alignment of sequences newly presented with the Examiner’s Answer should be struck from the record” (Reply Br. 3 (footnote omitted)). We interpret Appellants’ assertions to be a request that the Examiner’s reliance on Osumi be withdrawn or alternatively that prosecution be reopened. Therefore, we remand the application to the Examiner to either withdraw the citation of Osumi, or reopen prosecution and properly introduce Osumi as evidence of record. 37 C.F.R. § 41.39(2)(b)(1).

Additionally, we note that the sequence alignment for Osumi SEQ ID NO:24, which the Examiner indicated was attached to the Answer (Ans. 11), is missing from the Administrative Record. The application is further remanded to the Examiner to place this evidence in the record.

SUMMARY

The application is remanded to the Examiner for consideration of the issues cited herein.

¹ Osumi et al., US 6,891,084 B1, issued May 10, 2005.

Appeal 2007-4459
Application 08/992,914

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REMANDED

Ssc:

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